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THE TTAB**

September 29, 2005  
GDH/gdh

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Magnetic Ticket & Label Corp.

Serial No. 78389761

Seth M. Nehrbass of Garvey, Smith, Nehrbass & Doody, L.L.C. for  
Magnetic Ticket & Label Corp.

Lana H. Pham, Trademark Examining Attorney, Law Office 115 (Tomas  
V. Vlcek, Managing Attorney).

Before Hohein, Holtzman and Walsh, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Magnetic Ticket & Label Corp. has filed an application  
to register on the Principal Register the mark "ZIPPERCARD" for  
"magnetically encoded debit cards" in International Class 9.<sup>1</sup>

Registration has been finally refused under Section  
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that  
applicant's mark, when applied to its goods, so resembles the  
mark "ZIP CARD," which is registered on the Principal Register by  
the same registrant for both "magnetically coded debit cards" in

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<sup>1</sup> Ser. No. 76389761, filed on April 2, 2002, which is based on an  
allegation of a bona fide intention to use such mark in commerce.

International Class 9<sup>2</sup> and "credit and debit card services" in International Class 36,<sup>3</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entirety.<sup>4</sup>

Turning first to consideration of the respective goods and services, applicant asserts in its brief that its magnetically encoded debit cards are "different from the cards

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<sup>2</sup> Reg. No. 2,428,152, issued on February 13, 2001, which sets forth a date of first use anywhere of September 1, 1989 and a date of first use in commerce of August 22, 1991. The word "CARD" is disclaimed.

<sup>3</sup> Reg. No. 2,428,163, issued on February 13, 2001, which sets forth a date of first use anywhere of September 1, 1989 and a date of first use in commerce of August 22, 1991. The word "CARD" is disclaimed.

<sup>4</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." 192 USPQ at 29.

that are being sold by [the registrant, namely,] the University of Akron[,] on several levels." Specifically, applicant maintains that:

First, the cards being utilized by the University of Akron are for credit and debit card services or for debit cards, and it is understood ... that these are only issued to specific consumers, students of the university. Applicant's card are marketed on the open market, not only on the University of Akron campus. The cards which are being sold under applicant's mark, ZIPPERCARD, are cards which can be purchased anywhere and are cards which then become activated at the point of purchase. It is believed ... that the University of Akron cards are purchased on campus and are utilized solely by students enrolled and on the campus of the University of Akron and in no other places. ....

Applicant concludes, in view thereof, that "there can be no likelihood of confusion between the [respective] marks, since although the marks may arguably sound alike, they would not be marketed in the same channels of commerce since the University of Akron cards are limited to the campus as opposed to the universality of applicant's ZIPPERCARD."

As to the marks at issue, applicant insists that confusion is not likely in any event because:

The ZIP CARD registered mark ... is two separate words, and in fact the University of Akron has had to disclaim the word "card" apart from the mark because it is a separate word. Applicant's mark, ZIPPERCARD, is a one-word coined phrase, and there is no need to disclaim any part of the mark, since the mark itself is quite unique, unlike the two-word mark of the University of Akron. ZIPPERCARD looks different from and sounds different from the registered mark. It is respectfully submitted that ZIPPERCARD is so

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different in sound and appearance from ZIP CARD that on that basis alone there should be a finding of no likelihood of confusion.

The Examining Attorney, on the other hand, correctly points out in her brief that it is well recognized that the goods and/or services at issue need not be identical or even directly competitive in nature in order to support a finding of likelihood of confusion. Instead, she properly notes, it is sufficient that the respective goods and/or services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Here, as the Examining Attorney accurately observes, applicant's and registrant's goods "are identical because they are magnetic debit cards" and, thus, "customers would certainly encounter identical goods in the same normal channels of trade" therefor. As to registrant's services and applicant's goods, the Examining Attorney also properly notes that credit and debit card services "are closely related and complementary" to magnetically encoded debit cards. In support thereof, she points out that:

In the final Office Action, the Examining Attorney made of record several [use-based] third-party registrations from

the USPTO X-Search. These registrations have probative value to the extent that they serve to demonstrate that debit cards and debit card services often emanate from a single source. *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1218 (TTAB 2001), citing *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988). Indeed, ... the registrant in this case provides both debit cards and [credit card and] debit card services.

In addition, the Examining Attorney finds applicant's assertion that its debit cards are marketed in the open market and can be purchased anywhere, while registrant's goods and services are limited in their use to the University of Akron, to be "without merit." Besides noting, in particular, that applicant "provides no evidence to support this assertion," the Examining Attorney contends that, "even if the applicant's allegations are true, the [cited] registrations are not restricted or limited in the manner suggested by applicant." Maintaining that the "determination of whether there is a likelihood of confusion is made solely on the basis of the goods and/or services identified in the application and [any cited] registration, without limitations or restrictions that are not reflected therein," the Examining Attorney also correctly asserts that:

If the cited registration describes the goods and/or services broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, then it is presumed that the registration encompasses all goods and/or services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re*

*Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981); TMEP §1207.01(a)(iii).

The Examining Attorney accordingly insists that, like applicant's magnetically encoded debit cards, "it is presumed that the registrant's goods and services are marketed and sold in all [normal] channels of trade and that they can be purchased and/or provided to all potential customers."

With respect to the marks at issue, the Examining Attorney argues that, "[w]hile the marks are not identical, they are highly similar in appearance, [sound,] meaning, and overall commercial impression." The Examining Attorney contends, in this regard, that:

In this case, the applicant's proposed mark and the registrant's marks [sic] have the same word pattern, namely, the marks begin with "ZIP" and end with "CARD." Consequently, the marks are strongly similar in appearance, sound, meaning, and commercial impression. As noted in the Examining Attorney's first and final Office Action, ZIP is defined [by The American Heritage Dictionary of the English Language (3d ed. 1992)] as ZIPPER. The fact that applicant's mark consists [in part] of the word "ZIPPER" instead of "ZIP" does not obviate the likelihood of confusion. In addition, the applicant's mark and the registrant's marks [sic] contain the generic/highly descriptive word, CARD. While applicant's mark is compounded, [unlike registrant's two-word mark,] the mere deletion of a space ... is not sufficient to overcome a likelihood of confusion under Section 2(d). The separate words joined together form a compound word having a meaning or the same overall commercial impression ... identical to that of registrant's [mark]. Therefore, the applicant's mark and the registrant's marks [sic] have the same appearance, [sound], connotation, and overall commercial impression.

Moreover, the Examining Attorney notes that applicant "admits [that] the marks 'arguably sound alike.'" The Examining Attorney also notes, however, that applicant has asserted that the marks at issue are dissimilar because, while registrant's "ZIP CARD" mark consists of two separate words with the word "CARD" being disclaimed, applicant's "ZIPPERCARD" mark is a compound term with no disclaimer of any portion thereof. In response thereto, the Examining Attorney contends that:

The ... marks must be considered in their entirety when determining whether there is a likelihood of confusion. A disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) .... Purchasers are not aware of disclaimers that reside only in the records of the U.S. Patent and Trademark Office.

In view thereof, the Examining Attorney concludes that "[c]onsumers encountering the respective marks in the marketplace are likely to mistakenly believe that the debit cards and credit and debit card services derive from a common source."

We agree with the Examining Attorney that, as to the respective goods and services, applicant's "magnetically encoded debit cards" are legally identical to registrant's "magnetically coded debit cards" and are closely related to registrant's "credit and debit card services." It is well settled, in this regard, that the issue of likelihood of confusion must be determined on the basis of the goods and/or services as they are respectively set forth in the particular application and the

cited registrations, and not in light of what such goods or services are asserted to actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, supra at 1815-16; CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., supra at 77. Thus, notwithstanding the fact that the cited registrations were issued to and currently are still owned by the University of Akron, it remains the case that because the goods and services recited therein--like the goods set forth in applicant's application--are broadly described as to their nature and type and contain no limitations or restrictions as to either the channels of trade therefor or the classes of purchasers thereof, registrant's goods and services must be presumed--like applicant's goods--to be universally available.

Furthermore, and in any event, even if registrant's goods and services were to be implicitly limited or restricted to magnetically coded debit cards and credit and debit card services provided solely to students, faculty and employees of, and those professing an affinity with, the University of Akron, it is still the case that because applicant's magnetically encoded debit cards, as identified in its application, contain no such limitations or restrictions, applicant's goods must be presumed to be marketed to all members of the general public, including those persons who attend are or otherwise employed by or



associated with the University of Akron. Accordingly, because applicant's goods and the goods and services of registrant are legally identical in part and, as confirmed by the five third-party use-based registrations of record,<sup>5</sup> are otherwise closely related, the contemporaneous use of the same or similar marks in connection therewith would be likely to cause confusion as to source or sponsorship thereof.

Turning, therefore, to consideration of the marks at issue, we note as a preliminary matter that, as the Examining Attorney correctly points out, a side-by-side comparison of the respective marks is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733

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<sup>5</sup> The registrations, in each instance, list for example such goods and services as "magnetically encoded debit cards," "magnetically encoded credit and debit cards," "magnetically encoded plastic access cards for use in banking" and "debit cards," on the one hand, and "credit card services, ... debit card services," "credit card and debit card services," "credit card services; debit card services" and "credit card services, ... debit card services," on the other hand.

(TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB 1975).

Additionally, we observe that, as mentioned by the Examining Attorney, while marks must be considered in their entirety, including any descriptive matter therein, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., supra at 751. For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark ...." Id.

With the above principles in mind, we concur with the Examining Attorney that, when considered in their entirety, the marks at issue are substantially similar in sound, appearance, connotation and commercial impression. Specifically, given that the word "CARD" is generic in relation to debit cards and credit card and debit card services, it is plain that the dominant and source distinguishing portions of applicant's "ZIPPERCARD" mark and registrant's "ZIP CARD" mark are, respectively, the substantially similar words "ZIPPER" and "ZIP," notwithstanding that, for a compound mark, a disclaimer of a generic term is not required. Applicant's mark would clearly be understood as if it

were in fact the two words "ZIPPER CARD" and, as pointed out by the Examining Attorney, the words "ZIPPER" and "ZIP" may be regarded as synonymous in meaning. In view thereof, and given that such words respectively constitute the first element of applicant's and registrant's marks, the marks at issue are so substantially similar in all respects that, when used in connection with magnetic debit cards and credit card and debit card services, confusion as to the origin or affiliation of such goods and services is likely to occur.

**Decision:** The refusal under Section 2(d) is affirmed.